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OFFICE OF PETITIONS

In re Patent No. 7,064,105 : DECISION ON REQUEST
Joullie et al. : FOR RECONSIDERATION OF
Issue Date: June 20, 2006 : PATENT TERM ADJUSTMENT
Application No. 09/767,080 : and
Filed: January 22, 2001 : NOTICE OF INTENT TO ISSUE
Atty Docket No. 1694.0640001 : CERTIFICATE OF CORRECTION

This is a decision on the "Request for Reconsideration of Patent Term Adjustment Determination Under 37 C.F.R. § 1.705(d)" filed August 21, 2006. Patentees request that the Patent Term Adjustment (PTA) for the captioned patent be corrected to allow an addition of 77 days to the current PTA of 621 days, for a total PTA of 698 days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED to the extent indicated herein.**

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of seven hundred (700) days.

On June 20, 2006, the above-identified application matured into U.S. Patent No. 7,064,105. The instant request for reconsideration filed Monday, August 21, 2006 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 621 days. Patentees dispute the reduction of 120 days associated with the filing of a declaration after the mailing of the notice of allowance. Patentees argue that the filing of the declaration should not have resulted in reduction of PTA because the filing of the paper was in response to an express request by the PTO. As such, patentees argue a reduction under 37 CFR 1.704(c)(8) is not warranted. Patentees also disclose that

pursuant to 37 CFR 1.704(c)(10), a period of reduction of 42 days should be entered for the filing of a supplemental Information Disclosure Statement on August 4, 2005.

With respect to the reduction associated with the IDS, patentees are correct that a reduction is warranted. However, the period of reduction is 41 days (not 42 days as asserted by patentees), beginning on August 4, 2005, the date of filing of the IDS and ending on September 13, 2005, the date of mailing of the supplemental notice of allowability in response.

With respect to the reduction of 120 days for the filing of the declaration, patentees' argument is not well founded. This reduction was entered pursuant to § 1.704(c)(10), not § 1.704(c)(8).

37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months; ...

The relevant declaration falls within 37 CFR 1.704(c)(10) as it is a paper filed after the mailing of the notice of allowance. Further, § 1.704(c)(10) does not exclude papers requested by the examiner. Any paper, other than one which the Director has deemed its filing after the mailing of the notice of allowance does not constitute a failure to engage, filed after the mailing

of the notice of allowance may lead to entry of a period of reduction.

Nonetheless, a review of the record reveals that entry of the period of reduction pursuant to 37 CFR 1.704(c)(10) for the filing of the declaration is not warranted. The declaration was submitted on February 6, 2006 with evidence that it was a copy of a declaration originally submitted June 22, 2001. The record supports a conclusion that the originally submitted declaration was lost by the Office. The original transmittal of the declaration is present in the application with a date of receipt of June 22, 2001. Under the circumstances of the resubmission, it is appropriate to treat the declaration as submitted on or about June 22, 2001, prior to the mailing of the Notice of Allowance on July 5, 2005. Moreover, the resubmission of the missing declaration on February 6, 2006 did not constitute a failure to engage within the meaning of 37 CFR 1.704(c)(10).

In view thereof, the patent term adjustment indicated on the patent should be seven hundred (700) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **SEVEN HUNDRED (700)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,064,105 B2
DATED : June 20, 2006
INVENTOR(S) : Jouilie et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (621) days

Delete the phrase "by 621" and insert - by 700 days--